



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,241	12/28/2001	Susan Fox Jacobsen	00394 US1	8520
28880	7590	11/24/2004		
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			EXAMINER COLEMAN, BRENDA LIBBY	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/033,241

Applicant(s)

JACOBSEN ET AL.

Examiner

Brenda Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,8,11 and 12 is/are allowed.
- 6) ☒ Claim(s) 1-6,9,10,13-19 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claims 1-19 and 23-26 are pending in the application.

This action is in response to applicants' amendment filed October 19, 2004.

Claims 1, 8, 13 and 14 have been amended and claims 20-22 were canceled.

Response to Amendment

Applicant's amendments filed October 19, 2004 have been fully considered with the following effect:

1. With regards to the 35 U.S.C. § 112, first paragraph rejection of claims 1-6, 9, 10 and 13-26 of the last office action, applicants' state that "prodrugs has been stricken from claim 1". However, this is not so, prodrug appears in the second from last line of claim 1.

Claims 1-6, 9, 10, 13-19 and 23-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for reasons of record and stated above.

2. The applicants' amendments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled 2g) maintained in the last office action, which is hereby **withdrawn**.

Art Unit: 1624

3. The applicant's amendments and arguments are sufficient to overcome the objections to the specification labeled paragraph 6 and 7 of the last office action, which are hereby **withdrawn**.

4. The applicant's amendments and arguments are sufficient to overcome the 35 USC § 112, second paragraph rejections of claims 7 and 20 labeled paragraph 8 of the last office action, which are hereby **withdrawn**.

In view of the amendment dated October 19, 2004, the following new grounds of rejection apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 9, 13-19 and 23-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claim 9 is vague and indefinite in that it is not known what is meant by the m which appears in one of the moieties within the definition of an isotope where the isotope is ^{99m}Tc.

b) Claim 13 is vague and indefinite in that it is not known what is meant by the second occurrence of post-traumatic stress disorder. See lines 7 and the fifth line from the bottom of the claim.

- c) Claim 13 is vague and indefinite in that it is not known what is meant by the second occurrence of psychotic disorder. See lines 9 and the fourth line from the bottom of the claim.
- d) Claim 13 is vague and indefinite in that it is not known what is meant by the second occurrence of sleep disorder. See lines 8 and the fourth line from the bottom of the claim.
- e) Regarding claim 13, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
- f) Claim 14 is vague and indefinite in that it is not known what is meant by the second occurrence of post-traumatic stress disorder. See lines 7 and the fifth line from the bottom of the claim.
- g) Claim 14 is vague and indefinite in that it is not known what is meant by the second occurrence of psychotic disorder. See lines 9 and the fourth line from the bottom of the claim.
- h) Claim 14 is vague and indefinite in that it is not known what is meant by the second occurrence of sleep disorder. See lines 8 and the third line from the bottom of the claim.
- i) Regarding claim 14, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Art Unit: 1624

j) Claim 7 recites the limitation "eating disorders" in the list of disorders.

There is insufficient antecedent basis for this limitation in the claim.


Allowable Subject Matter

6. Claims 7, 8, 11 and 12 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brenda Coleman
Primary Examiner Art Unit 1624
November 23, 2004